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Application No.: 09/820,858

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David W. CANNELL et al.

Application No.: 09/820,858

Filed: March 30, 2001

For: HEAT ACTIVATED DURABLE
CONDITIONING
COMPOSITIONS COMPRISING
AN AMINATED C₃ TO C₅
SACCHARIDE UNIT AND
METHODS FOR USING THE
SAME

Group Art Unit: 1615

Examiner: B. Fubara

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Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

A. Restriction Requirement

In the Office Action mailed February 11, 2002, the Examiner has required
restriction between the following groups of claims:

Group I: Claims 1-48, 151, and 152, drawn to a composition comprising at least one compound comprising at least two quaternary ammonium groups and at least one compound comprising at least one C₅ to C₇ saccharide unit substituted with at least one amino group, and a kit, classified in class 424, subclass 70.13; and

Group II: Claims 49-150, drawn to method for caring for or treating at least one keratinous fiber comprising applying to said at least one keratinous fiber a composition comprising at least one compound comprising at least two quaternary ammonium groups and at least one compound comprising at least one C₅ to C₇ saccharide unit substituted with at least one amino group, classified in class 424, subclass 70.13.

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The restriction requirement, as set forth above and on page 2 of the Office Action, is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the subject matter of Group I, claims 1-48, 151, and 152.

The Examiner merely states that "the product can be used for different methods." See page 2 of the present Office Action. Applicants refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs Examiners as follows:

If the search and examination of an entire application can be made without **serious burden**, the Office **must** examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining the above groups together would constitute a serious burden. According to the present Office Action, Groups I and II are all classified in the identical class and subclass - class 424, subclass 70.13. Accordingly, a search for these groups of claims will substantially, if not completely, overlap. Thus, for at least this reason, Applicants respectfully submit that the restriction requirement is in error and request that the requirement be withdrawn.

B. Election of Species Requirement

The Examiner has also required an election of (a) a single disclosed species of the at least one compound comprising at least two quaternary ammonium groups and (b) a single disclosed species of the at least one compound comprising at least one C₅ to C₇ saccharide unit substituted with at least one amino group. Applicants traverse

these election of species requirements on the grounds that the Examiner has not shown that there would be a serious burden to examine all of the alleged species. In fact, the Examiner has failed to show that any burden exists. See pages 2-4 of the present Office Action.

However, to be fully responsive to the election of species requirement, Applicants elect with traverse, (a) polyquaternium-10 as at least one compound comprising at least two quaternary ammonium groups and (b) glucosamine as at least one compound comprising at least one C₅ to C₇ saccharide unit substituted with at least one amino group. Polyquaternium-10 is disclosed, for example, at pages 23-24 in the Example, and reads on claims 1-9, 13-48 and 151-152 of Group I. Glucosamine is disclosed, for example, at page 18, lines 9 and 12, at pages 23-24 in the Example, and reads on claims 1-16, 19, 20, 24-26, 35, 37-48 and 151-152 of Group I.

As discussed above, Applicants traverse the election of species requirement on the grounds that the Examiner has not shown that there would be a serious burden to examine all of the claimed species. Accordingly, Applicants respectfully request that the full scope of the claimed invention be examined in this application. If the Examiner chooses to maintain the election requirement, however, and the elected species is found to be allowable, Applicants expect the Examiner to continue to examine the full scope of the claimed subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to the non-elected species, as is the duty of the Examiner according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned at (202) 408-4173.

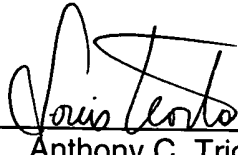
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Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P

By:  Reg No. 45,284
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Date: March 11, 2002

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